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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,992	11/03/2003	Randall T. Webber	5767-PA26	5347
27189	7590	11/06/2006	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			HWANG, VICTOR KENNY	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/699,992	WEBBER ET AL.
	Examiner	Art Unit
	Victor K. Hwang	3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 February 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-46 is/are pending in the application.
 4a) Of the above claim(s) 5,8,12,13,23,27,29-34,36,38 and 39 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4,6,7,9-11,14-22,24-26,28,35,37 and 40-46 is/are rejected.
 7) Claim(s) 1-4,6,7,9-11,14-22,24-26,28,35,37 and 40-44 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 03 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date Feb. 12, 2004.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species A	Figs. 1-6	Species B	Figs. 7 and 8
Species C	Figs. 10 and 11	Species D	Figs. 12 and 13
Species E	Figs. 16 and 16A	Species F	Figs. 17 and 18
Species G	Figs. 19-21	Species H	Figs. 22 and 23
Species I	Figs. 24-26	Species J	Figs. 27 and 28
Species K	Figs. 29 and 30	Species L	Figs. 31 and 32
Species M	Figs. 33 and 34	Species N	Figs. 35-38
Species O	Figs. 39 and 40	Species P	Figs. 41-44

The species are independent or distinct because the inventions as claimed have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3, 7, 17, 18, 40 and 41 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. During a telephone conversation with Katherine Proctor on October 17, 2006 a provisional election was made without traverse to prosecute the invention of Species A, claims 4, 6, 9-11, 14-16, 19-22, 24-26, 28, 35, 37, 42, 43, 45 and 46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5, 8, 12, 13, 23, 27, 29-34, 36, 38 and 39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

4. Claims 1-4, 6, 7, 9-11, 14-22, 24-26, 28, 35, 37 and 40-44 are objected to because of the following informalities:

in claim 1, the recitation “the user support frame” on lines 11 and 12 lacks proper antecedent basis and presumably refer to the user support recited on line 4;

in claim 1, the recitation “the moving parts of the machine” on lines 19-20 lacks proper antecedent basis and presumably refers to the user support, the at least one exercise arm, or the connecting linkage; and

in claim 24, the recitation “the connecting link” lacks proper antecedent basis and presumably refers to the connecting linkage recited on line 15 of claim 1.

Claims 2-4, 6, 7, 9-11, 14-22, 25, 26, 28, 35, 37 and 40-44 depend from claims 1 or 24 and are likewise objected to.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4, 6, 7, 9-11, 14-22, 24-26, 28, 35, 37, 40-44 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitations “the user engagement means is located in front of the shoulders of a user in a seated position on the user support frame” on lines 10-11 and “the user engagement

means is located above the head of the user with the user support frame in the end position" on lines 13-14 set forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 14, the recitations "the user support pivot mount is positioned at a predetermined location ... beneath the user's body when supported on the frame" on lines 1-3 and "portions of the combined weight of the user and user support frame are distributed one each side of the gravitational centerline ... and only a portion of the combined weight passes through the gravitational centerline during the exercise movement" on lines 7-11 set forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 15, the recitation "the user support pivot mount is located behind the hips of a user seated on the user support" sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 16, the recitation "approximately 75% of the total weight of the user and user support is positioned in front of the gravitational centerline..." sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form

part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 19, the recitation “a gravitational centerline extending through the user’s body in each of said user positions” on lines 4-6 sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 20, the recitation “the gravitational centerline extends through the user’s body adjacent the hips … and through the user’s shoulders...” sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

In claim 46, the recitation “the handle is located directly above the head of the user seated on the user support frame” on lines 3-4 sets forth recitations describing the elements of the invention with respect to a particular user. As the particular user cannot form part of the invention, and it is impossible to ascertain the correspondence between a particular apparatus and the invention until a particular user engages the apparatus, the claim is indefinite.

Claims 2-4, 6, 7, 9-11, 17, 18, 21, 22, 24-26, 28, 35, 37 and 40-44 depend from claim 1 and are likewise indefinite.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 6, 14, 17-19, 21, 22, 24, 25, 28, 37, 45 and 46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10/633,805 (US Pat. App. Pub. 2005/0032611 A1, as amended 9/25/06). Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the claimed limitations of claims 1-4, 6, 7, 9-11, 14-22, 24-26, 28, 35, 37 and 40-46 of the instant application are disclosed or inherent in claims 1-58 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 9-11, 14-16, 19-22, 24, 25, 28, 37 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by *Huang* (US Pat. 5,643,147). *Huang* discloses an exercise machine that can be used for shoulder press exercises. The machine (Fig. 6) comprises a main frame 10 having a user support pivot mount 114, a forward end (right side of drawing in Fig. 6) and a rear end (left side of drawing in Fig. 6). A user support 20 is pivotally mounted on the user support pivot mount for supporting a user in a seated position and is movable between a start position and an end position. At least one exercise arm 32 is movably mounted on the frame and has user engagement means 322 for gripping by a user. The user engagement means is located such that it can be in front of the shoulders of a user in a seated position on the user support frame in the start position and be above the head of the user with the support frame in the end position. A connecting linkage 34 connects movement of the exercise arm to movement of the user support, whereby movement of the exercise arm from the start to the end position simultaneously rotates the user support from the start to the end position. A load 116, or the user, resists movement of at least one of the moving parts of the machine.

The exercise arm is moveably mounted on the frame for rotation about an exercise arm pivot 241 that is positioned rearward of the user support 22. The user support rotates in the same direction as the exercise arm. The user support pivot mount is positioned under the user support

frame, wherein approximately 75% of the total weight of the user and user support could be positioned in front of the gravitational centerline, defined by the pivot mount, in the start position and approximately 50% of the total weight is located on each side of the centerline in the end position. The gravitational centerline could extend through the user's body in each of the end position and start position. The gravitational centerline could extend through the user's body adjacent the hips in the end position and could extend through the user's shoulders in the start position.

The main frame is a base with the user support pivot mount mounted thereto. The exercise arm comprises a single rigid exercise arm 32 having opposite arm portions extending on opposite sides of the user support, the arm portions having outer ends, and angled handles 322 at the outer ends of the arm portions. The connecting link 34 is rigid, adjustable in length, and has a first end 341 pivoted to the exercise arm and a second end 342 pivoted to the user support frame. The load 116, or the user, is linked to the user support frame. The exercise arm is movably mounted on a rear upright 13 at the rear end of the main frame base.

11. Claims 1, 9, 10, 14, 15, 17, 19-22, 24, 25 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by *Lee* (US Pat. 5,722,918). *Lee* discloses an exercise machine that can be used for shoulder press exercises. The machine (Fig. 9) comprises a main frame 10 having a user support pivot mount 36, a forward end, and a rear end. A user support 6 is pivotally mounted on the user support pivot mount for supporting a user in a seated position and is movable between a start position and an end position. At least one exercise arm 4 is movably mounted on the frame and has user engagement means 4121 for gripping by a user. The user

engagement means is located such that it can be in front of the shoulders of a user in a seated position on the user support frame in the start position and be above the head of the user with the support frame in the end position. A connecting linkage 5 connects movement of the exercise arm to movement of the user support, whereby movement of the exercise arm from the start to the end position simultaneously rotates the user support from the start to the end position. A load, the user, resists movement of at least one of the moving parts of the machine.

The exercise arm is moveably mounted on the frame for rotation about an exercise arm pivot 3 that is positioned rearward of the user support. The user support pivot mount is positioned under the user support frame and can be beneath the user's body when supported on the frame. The pivot mount can define a vertical, gravitational centerline whereby the combined weight of the user and user support frame are distributed on each side of the gravitational centerline in both start and end positions and only a portion of the combined weight passes through the gravitational centerline during exercise movement. The user support pivot mount is located such that it could be behind the hips of a user seated on the user support. The gravitational centerline could extend through the user's body in each of the end position and start position. The gravitational centerline could extend through the user's body adjacent the hips in the end position and could extend through the user's shoulders in the start position.

The user support frame has a primary user support 6 and a secondary user support 8 held in fixed relative locations throughout an exercise movement, the primary support comprising a seat pad. The main frame is a base with the user support pivot mount mounted thereto. The exercise arm comprises a single rigid exercise arm 41 having opposite arm portions 412 extending on opposite sides of the user support, the arm portions having outer ends, and angled

handles 4121 at the outer ends of the arm portions. The connecting link 5 is rigid and has a first end pivoted to the exercise arm and a second end pivoted to the user support frame. The load (the user) is linked to the user support frame.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lin (US Pat. 5,352,171), *Stearns* (US Pat. 5,658,227), *Lin* (US Pat. 5,674,161), *Huang* (US Pat. 5,676,626), *Mansvelt* (US Pat. 5,702,328), *Bresksel* (US Pat. 5,827,158), *Stearns* (US Pat. 5,997,446), *Solland* (US Pat. 6,086,521), *Stearns* (US Pat. 6,302,832), *Webber et al.* (US Pat. App. Pub. No. 2005/0096197 A1), *Webber et al.* (US Pat. App. Pub. No. 2005/0096198 A1) and *Menshenin et al.* (SU 1674874 A1) disclose exercise machines capable of permitting shoulder press exercises and with some having structure reading upon the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor K. Hwang
October 31, 2006

JEROME DONNELLY
PRIMARY EXAMINER

